



Paper No. 15

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OFFICE OF PETITIONS

In re Application of
Blackburn, et al.
Application No. 09/993,342
Filed: November 5, 2001
Attorney Docket No. A-68718-4/RFT/RMS/RMK
For: DEVICES AND METHODS FOR BIOCHIP
MULTIPLEXING

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ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(6), filed June 23, 2002 (certificate of mailing date June 19, 2003), which requests that the Office accept an unintentionally delayed claim under 35 USC 119(e) for the benefit of a prior filed provisional application.

The petition is **GRANTED**.

The instant petition requests acceptance of a delayed claim of benefit of provisional application No 60/245,840, filed November 3, 2000.

Generally, a claim of benefit under 35 U.S.C. 119(e) is required to be filed during the pendency of the nonprovisional application that seeks to claim the invention disclosed in an earlier-filed provisional application.¹ However, when the nonprovisional application is filed on or after November 29, 2000, as is in the instant case, the claim of benefit must be filed **not merely** during the pendency of the nonprovisional application, **but** within either 4 months of its filing date, or 16 months of the filing date of the provisional application, whichever is later.²

The claim of benefit submitted with the instant petition is filed during the pendency of the nonprovisional application, but subsequent to March 5, 2002. Such a delayed claim of benefit under 35 U.S.C. 119(e) may be accepted under a petition that includes:

¹ Assuming the following conditions are also met: (1) the nonprovisional application is filed within 12 months of the filing date of the provisional application; (2) the provisional application is entitled to a filing date, has at least 1 common inventor as that named in the nonprovisional application, and discloses that common inventor's invention which is claimed in at least 1 claim of the nonprovisional application; (3) the basic filing fee for the provisional application has been paid. 35 U.S.C. 119(e)(1); 37 CFR 1.78(a)(4).

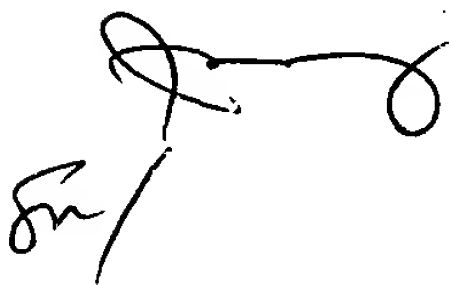
² 37 CFR 1.78(a)(5)(ii). In the instant case, the claim for benefit must be filed no later than 3/05/02 (4 months after the 11/05/01 filing date of the instant nonprovisional application).

- (1) The claim of benefit (in the form of a specific reference to the provisional application) in an application data sheet or in the first sentence of the specification following the invention title, unless previously submitted;³
- (2) The \$1,300 surcharge set forth in 37 CFR 1.17(t);⁴
- (3) A statement that the entire delay (between the time the claim of benefit was due and the filing of the claim) was unintentional.⁵

The petition meets the above requirements and is thus granted and the instant claim of benefit of Provisional Application No. 60/245,840 is accepted.

The application file is being forwarded to the Office of Initial Patent Examination for mailing of a corrected filing receipt that reflects the claim of benefit of Provisional Application No. 60/245,840, and correspondence regarding the revised projected publication date, if appropriate.

Telephone inquiries should be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

³ 37 CFR 1.78(a)(5)(iii), (6)(I). The instant petition is accompanied by an amendment that includes, in the 1st sentence of the specification, a reference to the claim of benefit of the provisional application.

⁴ 37 CFR 1.78(a)(6)(ii).

⁵ 37 CFR 1.78(a)(6)(iii); contained in petition.